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PATENT APPLICATION

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IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Henry, et al.

Application No.: 09/576,093

Filing Date: 05/22/2000

Title: INFORMATION CACHING SYSTEM AND METHOD

Confirmation No.: 2499

Examiner: Eng, David Y.

Group Art Unit: 2155

Mail Stop Appeal Brief-Patents
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF REPLY BRIEF

Sir:

Transmitted herewith in *triplicate* is the Reply Brief with respect to the Examiner's Answer mailed on 01/04/05. This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new grounds of rejection.)

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Respectfully submitted,

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In Re Application of:

Henry, et al.

Serial No.: 09/576,093

Filed: May 22, 2000



Group Art Unit: 2155

Examiner: Eng, David Y

Docket No. 10002031-1

For: **Information Caching System and Method**

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RESPONSE TO EXAMINER'S ANSWER

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Sir:

This is a Response to an Examiner's answer filed by Examiner David Y. Eng, sent on

January 4, 2005.

I. STATUS OF THE CLAIMS

Claims 1, 5-10, 12-24, and 30 are pending in the application. The Examiner's Answer maintains the rejections of claims 1, 5-10, 12-24, and 30, and generally repeats the arguments advanced during prosecution of this application along with providing comments to the Appeal Brief. With regard to the substantive remarks of the Examiner's Answer, Appellants disagree. Appellants will address some issues raised in the Examiner's Answer. Appellants continue to repeat, re-allege, and incorporate by reference the positions and arguments set forth in the Appeal Brief.

II. ARGUMENTS

With regard to the Examiner's comments on the summary, Appellants wish to point out that all of the claims have the feature of receiving an entry input by a user at the sending device. As emphasized in the Appeal Brief, the entry, whether it is an email address or fax number, is entered *at the sending device*. The statement on page 2, section (5) of the Examiner's Answer ("In response to entering of an address (sending address)") appears to improperly discount or de-emphasize an explicitly claimed feature of all of the claims.

With regard to the Examiner's Response to Arguments section (11) on page 6, Appellants wish to address some of the comments, and in particular, the limitations designated in the Examiner's Answer as (a), (b), and (c) of claim 9. Initially, Appellants do not believe that claims 1, 9, 15, and 20 stand or fall together, at least since each of these claims are of different scope. However, since arguments were presented to claim 9 in the Examiner's Answer, Appellants will address those arguments as applied to claim 9, with the understanding that similar arguments may apply to like limitations found in other claims.

With regard to element (a) ("responsive to the entry, cross-referencing the sending information entered by the user with a contacts database"), Appellant has reproduced the cited section of *Nielson* pertaining to FIG. 5 (col. 7, lines 15-25) below:

FIG. 5 illustrates the preferred steps for updating the sender's address book with the recipient's new email address. In step 501, the method retrieves the sender's address-book. In step 503, the method searches the retrieved address-book for the recipient's old email address. If not found (step 505), the method adds the recipient's new email address to the address book (step 507). If found (step 505), the method replaces the recipient's old email address with the recipient's new email address (step 509). Upon completion of steps 507 or 509, processing ends in the method of FIG. 5.

As Appellants have maintained throughout prosecution on this issue, this section does not state that the cross-referencing is responsive to the entry at the sending device. Appellants direct the Examiner's attention to "the" in the phrase "responsive to *the entry*" for claim element (a), which clearly indicates that there is an antecedent basis to "entry." The antecedent basis is found in the first claim element of claim 9, which clearly provides that "the entry" is at a "sending device." There is absolutely no support for an entry at the sending device in the cited section of *Nielson*, nor is there support for a cross-referencing that occurs in response to this entry.

Further, Appellants believe the Examiner is not according the proper weight to the "responsive to" portion of element (a). In other words, the plain ordinary meaning of that phrase is simply being ignored. One wouldn't say that cross-referencing occurs responsive to an entry in *Nielson* just like one wouldn't say this Response is being prepared responsive to the Examiner preparing an Examiner Answer.

Also, Appellants respectfully submit that the section cited by the Examiner should be considered in the context of the entire disclosure of *Nielson*, which discloses an address-change server that acts as an intermediary between the email program of the sending device and recipients. As illustrated in FIG. 3 of *Nielson*, a process is disclosed whereby an old

email address is sent from the sending device to the address-exchange server, the address-exchange server cross-references the old email address to the new email address, and the new email address is sent by the address-exchange server to the sending device. The reception of the email prompts a dialog box that queries whether the sender's address book should be updated (see col. 7). This process clearly does not meet the claimed features of "responsive to the entry, cross-referencing the sending information entered by the user with a contacts database." Thus, Appellants respectfully traverse the Examiner's Answer.

With regard to element (b) ("wherein the contacts database is stored within memory of the sending device"), Appellants disagree that this limitation is being suggested by *Nielson*. Appellants note that there are apparently two cross-referencing operations taking place in *Nielson*. The first one is described in almost every claim in *Nielson*, and certainly every independent claim, which describes a system or process involving an address-change server, the address-change server having a database (135, FIG. 1) that performs cross-referencing between an old email address and the new email address. Note that this cross-referencing occurs remotely from the sender computer despite the fact that the sender computer includes an email program (115, FIG. 1). The other cross-referencing is occurring at some undisclosed location as described in association with FIG. 5. Appellants respectfully assert that it is possible, given the context of the primary teachings of *Nielson*, that the updates to the address book discussed in association with FIG. 5 could be performed on an address book stored in the exchange server (103, FIG. 1) or some other server separate from the sender computer. Thus, *Nielson* does not necessarily suggest an address book located at the sender computer.

Also, Appellants do not propose that *Nielson*'s invention is inoperative. Appellants simply point out that the primary teaching of *Nielson*, as evidenced by the Abstract and the claims, is of an intermediary exchange server that handles cross-referencing between new and

old email addresses, with a database located remotely from the sender computer. Further, Appellants reiterate that combining *Reilly* is improper, in the context of what *Nielson* is teaching, because handling the cross-referencing as evidenced by the claims and abstract at the sender computer would mean that a recipient who changes his or her email address would have to contact each and every sender computer to inform the same of the address change. In contrast, by having the contacts database at the exchange server, there is one location for handling the cross-referencing issue.

In any event, because the claim elements are so intertwined, it is necessary to recognize that, in either cross-referencing operation (update as described in FIG. 5 or as claimed), none is done in response to an entry at the sending device. Thus, Appellants respectfully traverse the Examiner's answer.

With regard to (c) ("automatically caching the user-entered sending information in the contacts database if the user-entered sending information has not been previously saved"), Appellants re-iterate the arguments presented in the Appeal Brief, which includes an excerpt from the final Office Action that clearly equates the old email address with "*the entry*." In particular, the final Office Action provided as follows:

Receiving (see "BEGIN" in Figure 5) an entry (email message containing recipient's old email address, inherent from step 503) input by a user...

The final Office Action correlated the **sending information** with the recipient's **old email address** allegedly "entered" at a sending device. If there is now a change in position on what element or feature in *Nielson* is being equated to "the entry," then Appellants respectfully request further clarification on whether this is indeed a new position that supercedes the prior position.

III. CONCLUSION

Based upon the foregoing discussion, the Appellants respectfully request that the Examiner's final rejection of claims 1, 5-10, 12-24, and 30 be overruled and withdrawn by the Board, and that the application be allowed to issue as a patent with all pending claims.

No additional fee is believed to be due. However, any additional fee that may be due or required is authorized to be charged to deposit account no. 08-2025.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'David Rodack', is written over a horizontal line.

David Rodack
Registration No. 47,034